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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,202	02/27/2004	Friend K. Bechtel		9067

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Friend K. Bechtel
15902 E. Holcomb Rd.
Mead, WA 99021

EXAMINER

MILLS, DANIEL J

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 02/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/789,202

Applicant(s)

BECHTEL, FRIEND K.

Examiner

Daniel J. Mills

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of species 1 in the reply filed on 9/19/2005 is acknowledged. Applicant cancelled all claims to the non-elected species.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 recites the limitation "the cylinder" in line 4. There is insufficient antecedent basis for this limitation in the claim. In particular, it should be noted that no cylinder has been set forth and the recitation sets forth that the elongated longitudinal element is merely "substantially a cylinder". Accordingly, it is suggested that all recitations of "the cylinder" be changed to --the elongated longitudinal element--.

Claim 12 recites the limitation "both of the opposed directions" in line 12. It is unclear which directions applicant intends as there are infinite numbers of opposed directions. Accordingly, it is suggested that "both of the" be changed to --radially--.

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Claim 12 recites the limitation "longitudinal axis are projected in any direction perpendicular to the longitudinal axis" (line 10). It is unclear what is meant by applicant as it seems contradictory that the longitudinal axis projects in a direction perpendicular to itself.

Claim 15 recites the limitation "a prior art steel T-post" in line 2. It is unclear what is meant by this limitation, as what constitutes a "prior art" T-post is undefined. It would appear that "prior art" should be deleted.

With respect to claims 12 and 14, the parenthetical recitations in claims are improper.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating

obviousness or nonobviousness.

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Claim 12 is rejected under 35 U.S.C. 102(b) as being unpatentable over MontGuide.

Regarding claim 12, MontGuide discloses a T-post extender (Figure 2) comprising an elongated longitudinal element (3/8 inch rebar or fiberglass rod) having a longitudinal axis and a exterior surface that is substantially a cylinder, the longitudinal axis defined as the locus of points that are centroids of all cross sections of the cylinder, the cylinder having maximum extent in any direction perpendicular to the longitudinal axis of about 1/2 inch (3/8 is about 1/2 inch), the longitudinal element able to withstand bending moments in any direction perpendicular to the longitudinal axis of at least 200 pound-inch (applicant's disclosure asserts this for 3/8 inch rebar); a stop element surrounding the longitudinal element (the insulators attaching the rod to the T-post), the stop element in a selected position along the longitudinal axis, the selected position being relative to the longitudinal element, the stop element having maximum extent in the longitudinal axial direction of less than about 2 inch (it appears that this is likely the case from the scale of Figure 2), and, when the stop element and longitudinal axis are projected in any direction perpendicular to the longitudinal axis, the stop element has at substantially a first end of its extent in the longitudinal axial direction a projected profile that extends at least 1/2 inch in both of the opposed directions measured perpendicularly from the projected longitudinal axis (5/16 inch beyond the outer surface of the rod - it appears the insulator may extend this far in any two directions) and an attachment means for

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fixing the stop element to the longitudinal element at the selected position (the fit between the rod and insulator causes friction).

It is not specifically disclosed in the MontGuide reference whether the stop element has a maximum extent in the longitudinal direction of less than about 2 inches, and whether the projected profile extends at least $\frac{1}{2}$ inch measured perpendicularly from the projected longitudinal axis ($\frac{5}{16}$ inch beyond the outer surface of the rod). However it has generally been recognized that the optimization of dimensions and proportions in a prior art device is an engineering design consideration within the skill of the art. In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955), In re Reese, 290 F.2d 839, 129 USPQ 402 (CCPA 1961). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to optimize the insulator so that the stop element has a maximum extent in the longitudinal direction of less than about 2 inches, and the projected profile extends at least $\frac{1}{2}$ inch measured perpendicularly from the projected longitudinal axis to enhance the strength of the insulator as such practice is a design consideration within the skill of the art.

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over MontGuide as set forth in claim 12, above, and further in view of SARE.

Regarding claim 13, MontGuide discloses a T-post extender wherein the longitudinal element is a length of steel rebar, but fails to disclose the use of a flat washer as the stop element.

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SARE teaches the use of a washer welded to a length of rebar as a stop element (page 17 "Control" second paragraph), to reduce cost. Accordingly, it would have been obvious to one skilled in the fence post art at the time of applicant's invention to modify the arrangement of MontGuide to use a washer welded to a length of rebar as a stop element as taught by SARE to reduce cost.

Regarding claim 14, MontGuide in view of SARE discloses a T-post extender wherein the longitudinal element is a length of steel rebar and the stop element is a washer, but fails to disclose that the rebar is 1/2 inch diameter and that the washer is a 1/2 inch washer.

However, a change in the size of a prior art device is a design consideration within the skill of the art. In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955). It would have been a simple matter of engineering design choice at the time of applicant's invention, to choose 1/2 inch diameter rebar for its increased strength and it would have also been obvious to choose a washer with a 1/2 diameter hole, to allow it to fit onto the rebar, and it is capable of attachment by welding.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over MontGuide as set forth in claim 12, above, and further in view of Talt.

Regarding claim 11, MontGuide discloses a high fence support comprising a T-post extender in combination with a steel post having substantially a T-shaped cross section, and positioned vertically relative to the T-post in its downward direction by gravity and by the stop element of the T-post extender

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and that the T-post extender is disposed adjacent the T-post at its upper end, but fails to disclose the use of wire ties to capture the T-post extender laterally.

Talt teaches the use of wire ties to fix the T-post extender to a T-post due to the ease of use and durability. Accordingly, it would have been obvious to one of ordinary skill in the fence post art at the time of applicant's invention, to modify the arrangement of MontGuide to use wire ties to secure the T-post extender to the T-post as taught by Talt for the purpose of ease of use and durability.

Response to Arguments

Applicant's arguments filed 12/6/2006 have been fully considered but they are not persuasive.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

The arguments concerning the rejections of the claims based on the prior art points out supposed differences between the applicant's invention and the prior art, but applicant did not include any of these differences in the new claims. Accordingly, these remarks are not commensurate with the scope of the claims and have not been considered further.

The proper standard for determining obviousness under Section 103 in a combination rejection is what the combination of reference teachings taken

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collectively would have fairly suggested to one of ordinary skill in the art at the time of applicant's invention.

Conclusion

Applicant's amendment (cancellation of the original claims and the addition of new claims 12-15 which include limitations defining the longitudinal axis (claim 12 line 3), and further defining how the stop element is to be measured (claim 12 line 10)) necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Mills whose telephone number is 571-272-8115. The examiner can normally be reached on M-F 8:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 571-272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DJM

DJM
2/16/2006

JJ Swann
Supervisory Patent Examiner
Technology Center 3600